

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1, 2, 8-13, 17, 21, 25, and 29-53 are pending in this application. Claims 1 and 9-12 are amended. Claims 3-7, 14-16, 18-20, 22-24, and 26-28 were previously cancelled. Claims 1 and 9-12 are the independent claims.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 8-13, 17, 21, 25, and 29-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,923,627 to Miwa et al. ("Miwa") in view of U.S. Patent 6,044,408 to Engstrom et al. ("Engstrom"). The Applicant respectfully traverses this rejection.

According to the new Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103 in view of the Supreme Court decision of *KSR International, Co. v. Teleflex, Inc.* it is stated that the proper analysis for a determination of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. An Office Action must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. See 72 Fed. Reg. 57526, 57528-529 (Oct. 10, 2007).

The Applicant asserts that neither Miwa nor Engstrom, either separately or in combination, teach or suggest all of the limitations set forth in the claims, nor has there been a clear articulation made of why the differences between the prior art and the claims would have been obvious to one of ordinary skill in the art.

The Applicant respectfully asserts that the cited references do not teach, suggest, or otherwise render obvious, all of the limitations set forth in independent claim 1 for at least two reasons. First, independent claim 1 recites a “graphic image reproduction segment stores an indicator referring to the palette identifier for reproduction of the one or more graphic images.” The Applicant notes that on page four of the Office Action, the Examiner argues that the position of the cursor is used to identify where the color pattern is applied. The Examiner has interpreted the cursor position to be the identification of the color palette.

However, the Applicant notes that claim 1, as amended, recites that the graphic image reproduction segment “stores an indicator referring to the palette identifier for reproduction of the one or more graphic images.” The specific indicator is stored and decided by the author of the recording medium irregardless of a user's intention. In contrast, the position of the cursor in Miwa is an expression of the user's intention. Miwa does not store an indicator referring to the palette identifier for reproduction of one or more graphic images at a graphic image reproduction segment. Thus, Miwa does not teach, suggest or otherwise render obvious the above quoted portion of claim 1. Engstrom does not cure the insufficiencies of Miwa nor is it alleged to. Therefore, neither Miwa nor Engstrom whether taken separately or in combination teach, suggest or otherwise render obvious the above quoted feature of claim 1.

Claim 1 further recites “the graphic image reproduction segment is separate from the palette information segment.”

In an interview conducted June 24, 2009, the Applicant's representative Mr. Alan Larson and the Examiner discussed the fact that Miwa does not teach, suggest or otherwise render obvious a “graphic image reproduction segment” that is “separate from the palette information segment.” Therefore, for at least the reasons discussed

during the interview of June 24, 2009, the Applicant respectfully asserts that Miwa does not teach, suggest or otherwise render obvious a recording medium including "the graphic image reproduction segment...separate from the palette information segment."

Engstrom does not cure these insufficiencies nor is it alleged to. Therefore, the Applicant respectfully asserts that neither Miwa nor Engstrom whether taken separately or in combination teach, suggest or otherwise render obvious, all the features set forth in the claim 1. Further, there has been no showing of why the differences between the prior art and the claim would have been obvious to one of ordinary skill in the art. Therefore, *prima facie* case of obviousness has not been made. For at least these reasons, the Applicant respectfully requests that the rejections under 35 U.S.C. § 103 of independent claim 1 and its corresponding dependent claims be withdrawn.

The Applicant notes that the other independent claims, claims 9, 10, 11 and 12 contain language similar to that discussed above with respect to claim 1. Therefore, independent claims 9, 10, 11 and 12 and their corresponding dependent claims are patentable over Miwa and Engstrom, at least for the reasons set forth above. Therefore, the Applicant respectfully requests that the rejections under 35 U.S.C. § 103 of independent claims 9, 10, 11 and 12 and their corresponding dependent claims be withdrawn.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mr. Gary Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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